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No. 512

In the Supreme Court of the United States

OCTOBER TERM, 1959

UGO MONACO and MONTECATINI SOCIETA GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA ANONIMA, PETITIONERS

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

J. LEE RANKIN,
Solicitor General,

GEORGE COCHRAN DOUB,
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Washington 25, D. C.

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OPINION BELOW

The opinion of the Court of Appeals for the District of Columbia Circuit (R. 55-57) is reported at 270 F. 2d 335.

JURISDICTION

The judgment of the Court of Appeals was entered on August 27, 1959 (R. 58). The petition for a writ

of certiorari was filed on November 4, 1959. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether the Commissioner of Patents is prohibited from issuing a patent to the winning party in an interference proceeding during the pendency of an action by the losing party in the district court under 35 U.S.C. 146 to require the Commissioner to recognize its priority.

STATEMENT

This action was brought to enjoin the respondent from issuing a patent to the winning party in an interference proceeding during the pendency of the petitioners' civil action in the district court to require recognition of their priority.

The petitioners had filed an application for letters patent in the United States Patent Office, and the Commissioner of Patents had determined that the invention described therein interfered with a pending application by one Hoffman (R. 2). Pursuant to 35 U.S.C. 135, the conflicting applications were referred to the Board of Patent Interferences for a finding as to which party was the prior inventor. The Board determined the issue of priority of invention in favor of Hoffman (R. 3). The petitioners then brought a civil action, under 35 U.S.C. 146, in the district court to require the Commissioner to issue them the patent (R. 3). Upon the Commissioner's denial of the petitioners' request to hold up issuance of the patent to Hoffman, petitioners brought this action in the Dis-

trict Court for the District of Columbia (R. 4). The district court granted respondent's motion to dismiss (Pet. 5a-6a) and the court below affirmed, Judge Burger dissenting (Pet. 1a-3a).

ARGUMENT

This case involves a narrow question of construction of the patent laws to determine whether the Commissioner of Patents has jurisdiction to issue a patent to the successful party in an interference proceeding while the unsuccessful party is seeking relief in a district court. The language of the pertinent statute, 35 U.S.C. 135, provides for an adjudication by a Board of Interference Examiners and then states "and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." The report of the Senate Committee on Patents stated with respect to this provision (S. Rept. No. 877, 76 Cong., 1st Sess., pp. 1-2): "But even when appeal to the court is taken, in many cases it is possible to grant a patent immediately to the winning party without prejudicing the appeal, and in such cases the Commissioner can so grant the patent immediately." Thus, both the language of the statute and its legislative history support jurisdiction in the Commissioner to issue a patent under these circumstances.

The asserted conflict between the court below and the Court of Customs and Patent Appeals does not exist. The decision stated to be in conflict, *In re Allen*, 115 F. 2d 936 (C.C.P.A.), dealt with a distinct review procedure before the Court of Customs

and Patent Appeals[1] and did not purport to decide on the jurisdiction of the Commissioner in the circumstances of the present case.[2]

If the petitioners are successful on the merits, the interfering patent will, under the provisions of 35 U.S.C. 135, be modified to recognize the prior rights of the petitioners. Therefore, the most that is involved is interim relief.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

J. LEE RANKIN,
Solicitor General.

GEORGE COCHRAN DOUB,
Assistant Attorney General.

DECEMBER 1959.

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[1] In spite of petitioners' assertion that foreigners are precluded from following this alternative review procedure, the Court of Customs and Patent Appeals has accepted jurisdiction in such cases. *Norman* v. *Schmidt*, 125 F. 2d 162.

[2] Actually, the case cited does not even hold that a patent may not be issued by the Commissioner when an appeal to the Court of Customs and Patent Appeals from an interference adjudication is pending since the case dealt only with appeals from the Commissioner's rulings on patentability.

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